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Remarks

Reconsideration is requested. Claims 28-35 are presented.

Claims 28-33 (all previously pending claims) were finally rejected under 35 U.S.C. 103 as being unpatentable over Kowaguchi (U.S. Patent No. 6,201,973) in view of Tomoike (U.S. Patent No. 6,233,447) and in further view of Murayama (U.S. Patent No. 6,643,514). It is respectfully submitted that independent claim 28 is not rendered obvious in view of these references for the reasons explained below.

Arguments presented by applicant's communication of August 10, 2005 were addressed in the Advisory Action of September 23, 2005. In response to applicant's arguments that Murayama did not show or suggest the steps of receiving a first signal and preventing activation of the audible incoming call indicator in the mobile communication device, it was pointed out in the Advisory Action that:

"...claim 28 does not specifically mention where the prevention of the indicator is executed from within the mobile station. It is not indicated where the prevention activation signal comes from; therefore, broadly interpretation of the claim allows Murayama's reference to read where, when the system is overload, due to high traffic, the disabled condition is activated...."

Claim 28 has been amended to further clarify that a prevent activation control signal is generated by the mobile communication device to prevent activation of the audible incoming call indicator at the mobile communication device in response to the receipt of the first signal. As explained by applicant in prior communications, Murayama is directed to distributing call requests among a plurality of processors in infrastructure equipment. In a previous Office Action it had been alleged that Murayama taught receiving at the mobile communication device a first signal from a supporting exchange representing that it was in a high traffic area. Since Murayama is only concerned with sharing the call processing load among processors located in infrastructure equipment, it is believed to be clear that Murayama does not provide or suggest that a mobile communication device generate a prevent activation control signal that would prevent activation of an audible incoming call indicator at the mobile communication device. Only Murayama is relied upon as supplying this required element of claim 28. Therefore, the three applied

references, considered in combination (assuming that such a combination would be proper), do not provide a prima facie ground supporting a rejection under 35 U.S.C. 103 of claim 28. Withdrawal of the rejection is sought.

One of ordinary skill the art would not have been led to combine the teachings of Thompson with the other applied references. This is because Thompson has a general objective to not place a heavier load, i.e. require additional processing or actions, on an already congested exchange. Thus, one of ordinary skill the art would not be led to combine the teachings of Thompson with the other references. More specifically, based on Thompson one would not have been led to attempt to send information to a mobile, especially about an attempted call that is intentionally not to be set up with the mobile, since such a communication would inherently increase the load on an already congested exchange. Therefore, Thompson teaches away from the claimed invention in a material respect and cannot be utilized in combination with the other references to establish a prima facie ground for rejection.

In the Advisory Action the arguments presented in the above paragraph were addressed by stating:

"Thompson is a proper combination applied to [the combination of the other two references]. The general invention refers to restriction mobile terminals when they are found in a high traffic location/situation."

It is respectfully submitted that the above reasoning is insufficient to meet the required legal criteria.

...an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)

That is, an applicant can rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention or alleged combination in a material respect. In this situation the general objective of Thompson of not placing a heavier load on an already congested exchange would lead one of ordinary skill in the art to conclude that it would be

undesired to send a signal to a mobile to inform the mobile about an intentionally not set up call when the mobile is served by a congested area/exchange. It will be apparent that this is true because to take such an action would place an even heavier load on an already congested exchange, which is contrary to the objective of Thompson. Applicant has successfully rebutted the prima facie case of obviousness since Thompson is inappropriate to be combined with the other two references because of its teachings away from material requirements.

The conclusory comments provided in the Advisory Action are insufficient to establish a prima facie ground for combining Tomoike with the other references in view of the contrary teachings of Tomoike. It is believed to be well known that the entirety of a reference must be considered for its teachings, and when a reference has a material objective which would be contrary to its use in combination with another reference, then such a combination is impermissible.

Withdrawal of the rejection based on the combination of Tomoike is believed to be proper and is sought.

Claim 30 was also rejected under 35 U.S.C. 103 based on the same three references, and again Murayama was relied upon as applying the "receiving of a first signal" limitation as discussed above with regard to claim 28. For the reasons explained above, Murayama does not supply the required teaching, and hence the rejection of claim 30 based on the applied three references should be withdrawn.

Claims 32 and 33 were rejected under 35 U.S.C. 103 based on the same three applied references. Claim 32 defines the step of receiving at the mobile communication device a first signal as comprising receiving the first signal via a wireless transmission from the supporting exchange. Tomoike, at column 4, lines 58-67 and FIG. 2, was alleged to teach this additional requirement. It will be noted that the signal flow diagram of FIG. 2 of this reference clearly illustrates that mobile station 4 receives no command signals from the mobile communication exchange 3 in accordance with the teachings of the reference. Therefore, this reference does not teach or suggest the transmission of a control signal to the mobile station for any purpose, and certainly not a first signal is defined in accordance with claim 32.

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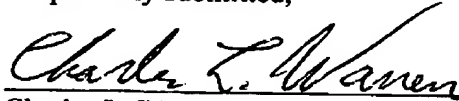
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Claim 33 is not rendered obvious for similar reasons discussed above with regard claim 32.

New claims 34-35 are presented.

If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney at 630-584-9206.

Respectfully submitted,



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